

*Application No. 10/699958*  
*Page 5*

*Amendment*  
*Attorney Docket No. M113.2N-10592-US02*

**Amendments To The Drawings:**

Please see Applicant's amendment to drawing Figure 1 as indicated in the Preliminary Amendment filed November 3, 2003.

**Application No. 10/699958**  
**Page 6**

**Amendment**  
**Attorney Docket No. M113.2N-10592-US02**

**Remarks**

This Amendment is in response to the Office Action dated **August 23, 2005**.

In the Office Action of August 23, 2005, the Examiner initially objected to the drawings pursuant to 37 C.F.R. §1.84(b)(5).

Applicant respectfully requests that the Examiner review Applicant's corrected Figure 1 and the amendment to the specification with Applicant's Preliminary Amendment of November 3, 2003. Applicant believes that the previous correction to the drawings and amendment to the specification fully complies with the requirements of the Examiner herein. Applicant respectfully requests reconsideration and withdrawal of the objection to the drawings/specification herein.

The Examiner next rejected claims 18-33 asserting 35 U.S.C. §103 over Diener '445 in view of Kalisz '152. Applicant respectfully traverses the Examiner's rejection of claims pursuant to 35 U.S.C. §103 herein.

In the Office Action, the Examiner asserted that Diener does not disclose the tube being magnetically attracted to the outside surface of the container. Kalisz discloses a tube storage device that is magnetically attached to the container. ....It would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute the attachment means of Diener with the magnetic attachment means as taught by Kalisz.

Applicant respectfully traverses the Examiner's assertion as to the teachings of Diener '445 in view of Kalisz '152.

Diener '445 discloses a mechanical storage clip 10, mechanical clamp member 12, and mechanical mounting strap 14. No disclosure, suggestion, and/or teaching is included in Diener '445 to provide an applicator comprising a tube, said tube being formed of material constructed and arranged to be magnetically attracted to the container.

Kalisz '152 teaches the use of a sleeve 30 having side wings 32, 34. The sleeve 30 is taught to include at least one storage hole or cavity 38. (Column 5, lines 5-15.) The Kalisz '152 reference further teaches the mechanical retention of the tube 40 within cavity 38. (Column 5, lines 11-15.) No disclosure or suggestion is provided in Kalisz '152 for the tube to be magnetically engaged to the sleeve 30.

*Application No. 10/699958*  
*Page 7*

*Amendment*  
*Attorney Docket No. M113.2N-10592-US02*

In column 6, lines 47-58, of Kalisz '152 a magnetic body 300 is disclosed for engagement to a can 10. The magnetic body (Fig. 10) also includes cavities 38 as discussed in connection with Figs. 1, 2, and 3. In lines 54-58 of column 6, Kalisz '152 teaches that only one of cavity 38, recessed portion 50, and peg 60 is necessary to retain at least one tube 40 by inserting tube 40 into body 300 and engaging body 300 to can 10.

The Kalisz '152 reference only discloses the mechanical engagement of the tube 40 to the body 300, sleeve 30 which includes a hole or cavity 38. In fact, Kalisz '152 only discloses the mechanical engagement of the tube to a tube holder (body 300, sleeve 30) by specific reference to Figs. 1, 2, and 3. No suggestion, disclosure, or teaching is provided in Kalisz '152 for magnetic engagement between a tube 40 and a body 300, or sleeve 30. No suggestion, disclosure, or teaching is provided for direct magnetic engagement between a tube and the exterior surface of a can.

Both the Kalisz '152 and Diener '445 references completely fail to provide any disclosure related to the direct magnetic engagement of a tube to the exterior surface of a can 10. The disclosure of Kalisz '152 and Diener '445 is directed to the mechanical engagement between a tube and a tube holder or support. In addition, Diener '445 and Kalisz '152 are directed to the mechanical and magnetic engagement of a holder to the exterior surface of a can.

Kalisz '152 does not suggest the elimination of the tube support (body 300, sleeve 30) for direct engagement of the tube to the can.

Kalisz '152 and Diener '445 commonly disclose a non-magnetic tube. In addition, both of these references teach the mechanical engagement between the tube and a tube holder.

Diener '445 teaches the affixation of the tube holder to the exterior surface of the can by mechanical means. Kalisz '152 teaches the affixation of the tube holder to the exterior surface of the can by both mechanical and magnetic means. The combination as asserted by the Examiner, which Applicant contests, would only suggest that the Diener '445 mechanical tube holder could alternatively be magnetic. Both Diener '445 and Kalisz '152 are directed to the engagement between the tube holder (and not the tube) to the can. As such, neither reference is applicable to Applicant's invention herein.

In addition, Applicant respectfully asserts that no suggestion, teaching, or

*Application No. 10/699958*  
*Page 8*

*Amendment*  
*Attorney Docket No. M113.2N-10592-US02*

disclosure, is provided in either of the Diener '445 or Kalisz '152 references, either explicitly or implicitly, to combine references as asserted by the Examiner. *In re Clinton*, 527 F.2d 1226, 188 USPQ 265 (CCPA 1976). Obviousness may not be established by combining the teachings of the prior art to produce the claimed invention, absent a teaching or suggestion supporting the combination. *In re Fine*, 5 USPQ 2d, 1596 (1988) (Fed. Cir. 1989).

Applicant respectfully asserts that neither the Diener '445 nor Kalisz '152 references suggest Applicants invention without the impermissible use of hindsight. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983); *In re Dembiczak*, 50 U.S.P.Q.2d 1614 (CAFC 1999).

For the above-identified reasons, Applicant respectfully requests reconsideration and allowance of claims 18-33 herein. Applicant respectfully asserts that claims 18-33 are in condition for allowance and early action to that effect is earnestly solicited.

#### **FORMALITIES**

Should the Examiner have any questions concerning this Amendment, then the Examiner is cordially invited to contact the undersigned by telephone, facsimile, and/or E-Mail at the below identified address. If an extension of time is required to make this response timely and no separate petition is enclosed, Applicant hereby petitions for an extension of time sufficient to make the response timely. In the event that the response herein requires the payment of additional government fees and payment is not enclosed, please charge Deposit Account No. 22-0350.

*Application No. 10/699958*  
*Page 9*

*Amendment*  
*Attorney Docket No. M113.2N-10592-US02*

**Conclusion**

It is believed that claims 18-33 in the present application are in condition for allowance in view of the foregoing. Applicant respectfully requests reconsideration of the claims herein and that the rejections be withdrawn and the claims allowed. Applicant respectfully requests the Examiner to reconsider the claims as amended herein which Applicant believes puts the application in condition for allowance. Early action to that effect is earnestly solicited.

Respectfully submitted,

VIDAS, ARRETT & STEINKRAUS

Date: November 10, 2005

By: \_\_\_\_\_

  
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